

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. WADE WALKE,
NATHANIEL L. WIGANOWSKI, and
C. ALEXANDER TURNER, JR.

Application No. 09/833,782



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on June 2, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On September 9, 2004, an Examiner's Answer was entered in response to the Appeal Brief. Section 1208 of the Manual of Patent Examining Procedure (MPEP) states:

APPEAL CONFERENCE

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1206) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary.

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference. If it is determined that the rejection(s) should be maintained, the examiner responsible for preparing the examiner's answer will prepare the examiner's answer.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

Upon receipt of the appeal case by the Board of Patent Appeals and Interferences (Board), the Board should review the application prior to assigning an appeal number to determine whether an appeal conference has been held. If the examiner's answer does not contain the appropriate indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Board should return the application directly to the appropriate Technology Center (TC) Director for corrective action.

This return procedure by the Board should not be considered as a remand of the application. This procedure applies to all examiner's answers received by the Board on or after November 1, 2000.

The Examiner's Answer does not comply with § 1208 of the MPEP.

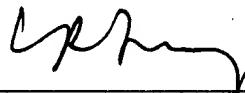
Additionally, we were unable to locate a copy of the Broun reference relied on by the examiner on page 8 of the Examiner's Answer mailed September 9, 2004.

Accordingly, it is

ORDERED that the application is remanded to the examiner

- for the examiner to correct the conferee requirement in the Examiner's Answer;
- for the examiner to have a complete copy of the Broun reference scanned into the electronic file; and
- for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



Craig R. Feinberg
Program and Resource Administrator
(571) 272-9797

Lexicon Genetics Incorporated
8800 Technology Forest Place
The Woodlands, TX 77381-1160

dem